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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 20

Application Number: 09/110,145  
Filing Date: July 02, 1998  
Appellant(s) : EGGERT ET AL.

**MAILED**

**JAN 18 2002**

Director's Office  
Group 3700

**REQUEST FOR REHEARING**

It is respectfully requested that the decision by the Board of Patent Appeals and Interferences (Board) dated August 3, 2001 in the above identified application (Ex parte Eggert et al, Appeal No. 2001-0790 (BPAI Aug. 3, 2001)) be reheard on the written record as supplemented below.

In the sole rejection before the Board on appeal, claims 15-22 stood rejected under 35 U.S.C. § 251 as being an improper recapture of broadened subject matter surrendered in the application for the original patent upon which the present reissue is based. The Board reversed this rejection based on the following. The Board concluded that reissue claims 15 and 22, and hence reissue claims 16-21 which depend from reissue claim 15, are, on balance, narrower than "the surrendered subject matter" in an aspect germane to the prior art rejection and broader only in aspects unrelated to the rejection. Therefore, the Board concluded that the claims are not barred under 35 U.S.C. § 251 by the so-called "recapture rule;" and thus, the claims, as amended in the reissue application, constitute a proper correction of "error without deceptive intent" as permitted by 35 U.S.C. § 251. The error being corrected under 35 U.S.C. § 251 was that patentees had claimed less than they had a right to claim, and correction of that "error" was held by the Board to be appropriate since the claims are permissibly broadened within two years of the issue date of original U. S. Patent No. 5,577,426 ('426 patent).

### PERIOD FOR REPLY

Appellant may file a reply to this request for rehearing within **two (2) months** of the mailing date of this request for rehearing. This two-month period may **not** be extended under the provisions of 37 CFR 1.136(a). After the expiration of this two-month period (plus an appropriate period for mail processing), the above-identified application will be forwarded to the Board for consideration of this request for rehearing.

### ISSUE

The sole issue is whether the Board erred as a matter of law in holding that the “surrendered subject matter” that cannot be recaptured in a reissue is limited to the claims canceled or amended during prosecution of the application that matured into the ‘426 patent after a rejection of those claims based on prior art. Such a holding resulted in the Board’s conclusion that it was correctible “error” within the meaning of 35 U.S.C. § 251 to broaden a limitation that was added to the claims to secure allowance of the ‘426 patent because the limitation as broadened did not result in a claim as broad as, or broader than, the canceled or amended claim(s).

### SUMMARY OF ARGUMENT

Under 35 U.S.C. § 251, a patentee is entitled to reissue only if an “error without deceptive intent” has occurred which renders the patent “wholly or partly inoperative.” The “error without deceptive intent” language appeared in the statutory codification/revision embodied in the 1952 Patent Act, but the underlying concept remains as essentially conceived and expressed in American jurisprudence at least as early as the 19<sup>th</sup> century. The case law on recapture presents a large number of decisions holding that when an applicant amends an

application claim by adding a limitation in order to secure allowance of that claim, that applicant is considered to have *prima facie* surrendered the right in a subsequent reissue application to claim his or her invention in broader terms that do not include that added limitation. Whether this concept is expressed as impermissible "recapture," or as surrender of claims to the invention that do not include the limitation added to secure allowance, or as an estoppel operating against the patentee (whereby the public should be able to rely upon the file history of the original patent), it is clear that the underlying basis upon which the doctrine is founded is as follows: After the addition of a claim limitation to secure allowance of a patent, an attempt to subsequently obtain patent protection by reissuing the patent with one or more claims that do not contain that limitation is impermissible because this is not a correctible error. To hold (as the Board did) that "surrendered subject matter" is to be defined as the original application claims that were canceled or amended in favor of a claim containing a specific limitation relied upon for patentability over the prior art (and thus, that a reissue application claim from which the limitation has been canceled may be properly allowed provided that the reissue claim is narrower than the canceled or amended claim with respect to that added limitation), is to ignore the principle which gave rise to the doctrine that it is not, *prima facie*, a correctible "error" within the meaning of 35 U.S.C. § 251, just as it was not, *prima facie*, "inadvertence, accident or mistake" under the predecessor statute (35 U.S.C. § 64, Section 4916, Revised Statutes), and just as it was not, *prima facie*, permissible to remove by reissue a limitation that had been added to a claim in order to secure its allowance in the original patent.

In the present case, the appealed reissue claims impermissibly recapture the "surrendered subject matter" because they fail to include the limitation "generally bowl-shaped, being convex toward said magnet," which was added to secure allowance of the '426 patent. Both the prosecution history of the '426 patent and the history of the prosecution of divisional

application 08/593,396 which matured into U.S. Patent No. 5,603,248 (the '248 patent), which has been reissued as U.S. Patent No. RE 36,797 ('797 reissue patent) show that appellant intentionally surrendered the subject matter now encompassed by the reissue claims. It is submitted that the Board committed reversible error when it held that the substitution in the reissue application of the limitation "and substantially covering said outer surface of said magnet" for the limitation "generally bowl-shaped, being convex toward said magnet" of the original patent was correctible error under 35 U.S.C. § 251. This holding is directly contrary to Federal Circuit precedent involving the "recapture doctrine."

### **ARGUMENT**

For the reasons set forth below, it is respectfully submitted that claims 15-22 are unpatentable over 35 U.S.C. § 251<sup>1,2</sup> as failing to be supported by "error without deceptive intent." Whether this rejection is considered to be based on the "recapture doctrine," or based on a surrender of claimed subject matter, it is submitted that there is no correctible error in this reissue application within the meaning of 35 U.S.C. § 251, and the examiner's rejection of claims 15-22 should be reconsidered and affirmed.

#### **A. Summary of Prosecution History of the '426 Patent**

As originally filed, and as allowed, application number 08/335,992, discloses an invention taking the form of a plurality of different techniques (embodiments) for securing or retaining a neodymium permanent magnet<sup>3</sup> within the bore of a bit holder into which bore a tool bit is to be received. The portion of the invention that is important to this appeal is the manner in which the magnet is secured or retained within the bore. In the embodiment of Figures 2 and

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<sup>1</sup> The holding set forth under the heading "Conclusion" of the Board's decision is to the effect that the rejection of claims 15-22 under 35 U.S.C. § 103 is reversed. Clearly, the Board intended to reverse the rejection under Section 251, the only rejection of record.

<sup>2</sup> Claims 15-21 were designated as standing or falling together, while claim 22 was designated as being "separately argued".

3, there is provided a flat, disk-like thin circular retainer formed of metal or plastic<sup>4</sup>.

Alternatively, in the embodiment of Figures 4-6, there is illustrated a retainer which is a generally circular, generally "bowl-shaped" disk formed of either plastic or metal<sup>5</sup>. Both the Figure 2-3 and Figure 4-6 embodiments are simply interference fit within the bore of the bit holder, against the "front" face of the magnet to retain the magnet within the bore. Figures 7, 8 and 9 disclose additional embodiments wherein the retainer is an encapsulation, surrounding the magnet. For the Figure 7 embodiment, the encapsulation may be an adhesive that surrounds the magnet, forming a distinct layer around the magnet, and the encapsulation may be applied to the magnet *in situ* within the bore, with the adhesive serving to bond the magnet in place.<sup>6</sup> Figure 8 illustrates an embodiment in which the encapsulation material is applied to the magnet prior to insertion of the magnet within the bore. The material may range from plastic to brass, and is a distinct layer that serves to retain the press fitted magnet within the bore, presumably by friction<sup>7</sup>. The embodiment in Figure 9 is similar to that of Figure 8, with the magnet having an encapsulation that does not extend over the "rearward" face of the magnet.<sup>8</sup> Claims 1-20 were originally filed, with claims 1 and 15 being independent claims directed to "a bit holder" and to a "hand tool", respectively. Each of the independent claims broadly required "retaining structure" in contact with the outer surface of the magnet interfitted within the bore so as to retain the magnet within the bore. The dependent claims added various features to the generically claimed invention of the independent claims. Claims 4 and 17 defined the "retaining structure" as being "a retaining member mounted in said bore outboard of said magnet." Claim

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<sup>3</sup> The magnet acts to releasably retain a bit within the bore of the bit holder.

<sup>4</sup> See the Abstract of the Disclosure, lines 6-11; specification, paragraph bridging pages 5 and 6; and Figure 2, element 26.

<sup>5</sup> See the Abstract of the Disclosure, lines 6-11; specification, first full paragraph on page 7, and element 35 in Figures 4-6.

<sup>6</sup> Specification, beginning with the second paragraph on page 8, and continuing onto page 9; see also element 51 in Figure 7.

<sup>7</sup> Specification, first full paragraph on page 9; see also element 56 in Figure 8.

5 defined the retaining member as being “substantially flat.” **Claim 6 defined the retaining member as “generally bowl-shaped, being convex toward said magnet.”** Claims 13 and 18 defined the retaining structure as being “encapsulation material.”

In the first Office action<sup>9</sup>, all claims were rejected on various grounds. Among the various grounds of rejection, all claims **except for claim 6** were rejected on prior art grounds. Appellant then filed an amendment<sup>10</sup>. Insofar as it is relevant to this appeal, that amendment amended independent claims 1 and 15 to recite:

“said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween.”

A new independent claim 21 was added, but was directed to the encapsulated material shown in Figures 7 and 8 (but not Figure 9). It is also important to note that claims 13 and 18, directed to the retaining structure being encapsulation material, were retained as depending from amended claim 1 and 15, respectively, notwithstanding that claims 1 and 15 had been amended to recite that the retaining structure was a “discrete” member. Appellant argued that claims 1 and 15 were patentable in that they had been amended to recite that the retaining structure was a discrete member “friction fitted” in the bore, and which cooperated with the end of the bore to retain the magnet therebetween.<sup>11</sup> **Appellant also included a specific argument vis-à-vis the structure of claim 6, arguing that the generally bowl-shaped convex arrangement provides an additional reason for patentability.**<sup>12</sup> However, notwithstanding this amendment, all pending claims except for claim 6 were finally rejected over prior art.<sup>13</sup>

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<sup>8</sup> Specification, paragraph bridging pages 9 and 10; see also element 61 in Figure 9.

<sup>9</sup> Paper No. 2, mailed June 15, 1995.

<sup>10</sup> Paper No. 3, filed August 31, 1995.

<sup>11</sup> Paper No. 3, page 4, last paragraph (but note that the claims recite “press fitted”, not “friction fitted”; see also page 5, beginning with the second paragraph.

<sup>12</sup> Paper No. 3, page 6, second paragraph.

<sup>13</sup> Paper No. 4, mailed November 15, 1995.

In response to the final rejection, appellant filed an amendment in which the subject matter of claim 6 was incorporated into the two independent claims in the application.<sup>14</sup> Thus, the independent claims were amended to incorporate the limitation:

“said retaining member being generally bowl-shaped and convex toward said magnet.” Appellant reiterated that this limitation, which the examiner had never addressed by citing prior art, and which appellant had specifically argued in the previous amendment, made the independent claims, and therefore all pending claims, allowable.<sup>15</sup> The record clearly shows that appellant had argued that the limitation:

“said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween,”

was the patentable subject matter in the application, and had **twice argued** that the further limitation:

“said retaining member being generally bowl-shaped and convex toward said magnet” made the application allowable.<sup>16</sup> The application was thereafter allowed, and matured into the ‘426 patent.

#### **B. Additional Relevant Prosecution History (The ‘248 Patent)**

On January 29, 1996, appellant filed application number 08/593,396 as a divisional application of application number 08/335,992. This application was filed pursuant to then-existing 37 CFR 1.60, and therefore the specification and claims were literally a copy of the parent application as filed.<sup>17</sup> A concurrently filed preliminary amendment added the following limitation to each of claims 1 and 15, the sole independent claims:

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<sup>14</sup> Paper No. 5, filed on January 22, 1996.

<sup>15</sup> Paper No. 5, page 3, beginning at the third full paragraph.

<sup>16</sup> See footnotes 10, 11 and 14, *supra*.

<sup>17</sup> See Manual of Patent Examining Procedure, 8<sup>TH</sup> Ed. (August 2001), Section 201.06(a).

“said retaining structure including a discrete, flat, imperforate retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween.”

The application, as amended by an examiner's amendment that merely reinserted a portion of a limitation that had been inadvertently omitted when presenting the preliminary amendment was then allowed, and matured into the '248 patent. The '248 patent has been surrendered in favor of RE 36,797.

### C. Additional Relevant Prosecution History (The '797 Reissue Patent)

Reissue application number 09/109,392 was filed on July 2, 1998 in order to correct certain errors in the '248 patent. The errors to be corrected are not relevant to the issues in this appeal, except that one error for which reissue was sought was that the retaining member was deemed to be too narrowly recited by reason of its having been claimed as “imperforate.” Therefore, new claim 17 reciting that the retaining member is “substantially covering said outer surface of said magnet” and new claim 24 reciting that the retaining member was formed as “having a continuous, closed, non-reentrant outer periphery” were added.<sup>18</sup> All claims were allowed over the prior art. Claim 24 was rejected for lack of original written description to support the new claim.<sup>19</sup> In a request for reconsideration filed on January 15, 1999, appellant argued the rejection of claim 24, and specifically noted that “a continuous, closed, non-reentrant outer periphery is clearly **disclosed in Figs. 2 and 3.**”<sup>20</sup> Ultimately, a reissue Continued Prosecution Application (CPA)<sup>21</sup> was filed on June 14, 1999, and the above quoted language of claim 24 was replaced with language defining the retaining member as “having a continuous outer periphery such that any two points on the periphery can be joined by a straight line

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<sup>18</sup> Original reissue declaration filed concurrently with application number 09/109,392.

<sup>19</sup> Paper No. 3.

<sup>20</sup> Paper No. 4, page 3, first full paragraph. (emphasis in text supplied.)

<sup>21</sup> 37 CFR 1.53(d)



segment which does not extend outside the periphery." This limitation was argued by appellant as being fully supported by the disclosure of **Figure 3** of the original patent.<sup>22</sup>

**D. Application of the Correct Interpretation of the Phrase "Surrendered Subject Matter" Mandates Affirmance of the Rejection of Record**

The rejection of claims 15-22 under 35 U.S.C. § 251 should be reconsidered and sustained when the facts of this appeal are considered in light of the correct legal standard, specifically, the correct definition of "surrendered subject matter."

In its decision in this appeal, the Board took the position<sup>23</sup> that the term "surrendered subject matter" means either a canceled or amended claim, wherein the Board defined "amended claim" to mean a claim in its form prior to being amended. The Board also cited Ball Corp. v. United States<sup>24</sup> for the proposition that with respect to "recapture" cases, "the focus is not on the specific limitations or on elements of the claims, but, rather, on the scope of the claims." The Board quoted language from the Ball case that the Board deemed to support this proposition. While language can be found in Ball, as well as in another "modern 'recapture' case,"<sup>25</sup> that "surrendered subject matter" relates to claims that had been canceled or amended during the prosecution of the original patent, a consideration of the history of the "recapture doctrine" shows that the focus of the inquiry should also include whether (a) there has been an error without deceptive intent (formerly "inadvertence, accident or mistake") so as to permit reissuing of the patent, or (b) *whether there has been a surrender or estoppel which bars a patentee in a reissue application from deleting a particular claim limitation which was added/argued in the original examination to overcome a prior art rejection.*

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<sup>22</sup> Paper No. 7, and in particular, see page 2, sentence beginning sixth line from the bottom of the page.

<sup>23</sup> Paper No. 17, footnote 4.

<sup>24</sup> 729 F.2d 1242, 221 USPQ 289 (Fed. Cir. 1984)

<sup>25</sup> Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)

An early example is the case of Shepard & Others v. Carrigan,<sup>26</sup> cited in many reissue cases. In that case, citing numerous earlier Supreme Court decisions, the Supreme Court stated:

**"Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent".** (Emphasis supplied.)

Another case of interest is In re Byers,<sup>27</sup> which relied upon Shepard and numerous other cases to the same effect. In Byers, the Court of Customs and Patent Appeals addressed the issue of the patentability of reissue claims of "intermediate scope;" that is, reissue claims with a limitation broader than that added to secure allowance, yet narrower than certain canceled claims in the application which had been canceled to secure allowance of the original patent. The court wrote:

**"[I]t is stated in the appellant's brief that claims 2 and 3 of the present appeal are intermediate in scope between certain broad claims which were canceled from appellant's original application and the limited claim allowed in the patent. Assuming that to be the case, it would not entitle appellant to the reissue sought here. The rejection is not based on the cancellation of the broader claims referred to in appellant's brief but on the limiting amendment which was of such a nature as to bar the allowance in a reissue application of the claims here on appeal. The fact that there were other claims whose cancellation did not constitute such a bar is immaterial.** (Emphasis supplied.)

Another case of interest is Riley v. Broadway-Hale Stores.<sup>28</sup> In Riley, the court wrote:

**"[T]he courts have uniformly held that a reissue patent is void if the matter claimed in the reissue was intentionally omitted or abandoned by the patentee during the course of his application for the original patent, that is to say, in such situation no error through inadvertence, accident, or mistake can be said to exist. (citations omitted). The present case belongs in that category. The original application included claims for shoulder pads without voids. All of the original claims were rejected by the Patent**

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<sup>26</sup> 116 U.S. 593, 6 S. Ct. 493, 29 L. Ed. 723 (1886)

<sup>27</sup> 43 CCPA 803, 109 USPQ 53 (CCPA 1956)

<sup>28</sup> 217 F.2d 530, 103 USPQ 414 (9<sup>th</sup> Cir., 1954)

Office. The claims to pads without voids were abandoned, but those for shoulder pads with voids were prosecuted. Eventually appellant accepted a patent limited to shoulder pads with voids, **and thereupon obtained the reissue primarily for the purpose of covering the very element deliberately abandoned.** The court concluded: “[I]n our opinion, **when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void.**” (Emphasis supplied.)

The above cases are examples of decisions in which the courts clearly indicated that the issue involved in what we today call “recapture” cases is more or less one of an attempt on the part of the patentee in a reissue application to remove a claim limitation that was added by the patentee in order to secure allowance of the original patent. While a reissue claim as broad as (or broader than) the canceled or amended claim as per the Ball case will be one case of impermissible recapture of “surrendered subject matter,” it is not the end of the inquiry. The ultimate question that must be answered is whether “error without deceptive intent”<sup>29</sup> occurred with respect to the prosecution of the original patent so as to render it wholly or partly inoperative. And that question has routinely and regularly been answered by the courts to the effect that the intentional addition of a limitation to a claim in order to secure allowance is at least *prima facie* evidence that the addition of the limitation is an intentional act. How then can an attempt to remove, or delete that limitation qualify as correctible error within the meaning of 35 U.S.C. § 251, regardless of whether the claim being asserted by reissue is broader than, as broad as, or narrower than an amended or canceled claim? Indeed, in Hester Industries v. Stein, Inc.<sup>30</sup>, a claim that had not been canceled and had not been amended could not be broadened on reissue because an argument directed to the importance of a claim limitation that had secured allowance of the claim for the patentee was held to be a surrender. What was held to have been surrendered was evidently the right to a claim without a particular limitation in it;

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<sup>29</sup> This standard, found in 35 U.S.C. § 251 is the same standard as in the predecessor statute, 35 U.S.C. § 64 (Section 4916 Revised Statutes). See Ball, cited in note 24, *supra*.

<sup>30</sup> 142 F.3d 1472, 46 USPQ 2d 1641 (Fed. Cir. 1998)

no claim had been canceled or amended during the prosecution of the application that ultimately matured into the patent for which reissue was sought, so there was no canceled or amended claim that could said to be the “surrendered subject matter.” Nevertheless, the Hester court found that the patentee recaptured subject matter he surrendered in the original prosecution. The holding in Hester appears to be in direct conflict with the Board’s view that surrendered subject matter is limited to the scope of a claim that was canceled or amended in the original prosecution. In Hester, the “surrendered subject matter” could only be all subject matter not including the particular limitation that had been argued as being of patentable moment.

In Mentor Corp. v. Coloplast, Inc.,<sup>31</sup> although the decision did include language which referred to claims that were canceled from the original application, the court nevertheless focused on the “transfer of adhesive” limitation, which was added during prosecution of the original application to overcome a prior art rejection, and the fact that this limitation was missing from the reissue claim. The Mentor court did not focus on comparing the claim scope of the original application (prior to the amendment that added the “transfer of adhesive” limitation) to the reissue claim to determine what constituted “surrendered subject matter.” The court found that the reissue claim was broader than the patent claim in a manner directly pertinent to the subject matter surrendered, i.e., the reissue claim deleted the limitation added during prosecution of the original application to overcome the prior art rejection. The court stated that “Coloplast correctly argues that reissue claim 6, which does not include the adhesive transfer limitation, impermissibly recaptures what Mentor deliberately surrendered in the original prosecution. Specifically, the reissue claims do not contain the limitation that, during rolling and unrolling, the adhesive be transferred from the outer to the inner surface of the catheter.”<sup>32</sup>

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<sup>31</sup> 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993)

<sup>32</sup> 998 F.2d at 996, 27 USPQ2d at 1525.

In the most recent decision from the Court of Appeals for the Federal Circuit on the issue of recapture, Pannu v. Storz Instruments,<sup>33</sup> the court did not engage in an analysis of the canceled or amended claims in the application that matured into the original patent for which reissue patent had been granted. The court merely noted (1) that reissue claim 1 was broader than claim 1 of the original patent, (2) that claim 1 in the original patent had contained limitations added to secure allowance, and (3) that the reissue patent omitted a limitation added to secure allowance of the patent. The court dismissed the patentee's argument that the recapture rule was avoided by reason of certain limitations added in the claims as-reissued that were narrower than the originally patent claim because the narrower limitations were not related to the "surrendered subject matter," and then the court went on to state that:

"if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution **this flexibility of analysis is eliminated**, for the prosecution history establishes the substantiality of the change and **estops its recapture**." (Emphasis supplied.)

The court further stated that:

"[i]n prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a 'continuous, substantially, circular arc.' On reissue, he is estopped from attempting to recapture **the precise limitation** he added to overcome prior art rejections." (Emphasis supplied.)

Again, the court appears to have viewed "surrendered subject matter" to be a claim (provided in the reissue application) that does not include the limitation added during prosecution of the original application to overcome the prior art rejection. The court did not refer to surrendering the right to a canceled or amended claim.

The above cited cases appear to indicate that notwithstanding the language in certain decisions which defines "surrendered subject matter" in terms of claims that were canceled in favor of more limited claims or amended to include narrower limitations in order to secure

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<sup>33</sup> 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001)

allowance, “surrendered subject matter” in fact also means a claim omitting the specific limitation which the record shows was added and/or argued to secure allowance.<sup>34</sup> Absent any contrary evidence, an applicant who adds such a limitation for the purpose of securing allowance is considered to have surrendered the right to claims in which that limitation has been broadened or discarded. After the application matures into a patent, the patentee is estopped from obtaining broadened reissue claims that do not contain that precise limitation. While 35 U.S.C. § 251 permits broadening of claim by way of reissue, not every error is correctible by reissue.<sup>35</sup> The reason for the broadening must be to correct an error without deceptive intent, or the equivalent error through accident, inadvertence or mistake. Merely taking the view that an applicant seeking reissue committed an error in judgment by presenting and arguing a limitation more narrow than was needed in order to secure allowance is not acceptable as being the sort of error for which reissue is available.

Applying the above analysis to the relevant facts in this appeal, discussed in subsections A-C of this section, *supra*, shows that the Board erred in reversing the 35 U.S.C. § 251 rejection of claims 15-22. The record of the prosecution history of the ‘426 patent clearly shows that the appellant expressly limited the claims to include the limitation “generally bowl-shaped, being convex toward said magnet” which was added to secure allowance of the patent, and which had twice been argued as specifically defining the point of patentability in this application. The record further shows that appellant filed the ‘248 divisional application, expressly rebutting the presumed surrender of the “bowl-shaped convex” limitation, and obtained claims covering the discrete flat disk of Figures 2-3 in addition to the coverage afforded by the ‘426 parent patent for the “bowl-shaped convex” disk of Figures 4-6. But appellant did not file a continuation

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<sup>34</sup> In most cases this distinction will not produce a different result, but when the facts show that a limitation that had been added to secure allowance has merely been broadened in the reissue application or patent, and not eliminated entirely, then the distinction is clearly critical.

application to obtain broader claims directed to Figures 4-6. Nor did appellant attempt to obtain claims directly readable on Figures 7-9 by filing a continuation application directed to the devices illustrated in those Figures<sup>36</sup>. It is clear that the public is entitled to rely upon the arguments of appellant during the prosecution of the '426 patent, the failure to file a continuing application with respect to the subject matter of the '426 patent, and the filing of a single divisional application directed only to one of the other embodiments which appellant disclosed and originally claimed, but then canceled in order to obtain allowance of the '426 patent as clear evidence that appellant surrendered claims directed to embodiments of retaining the magnet other than those obtained in the '426 patent and the subsequent '248 divisional patent. The public is entitled to rely upon this surrender of the right to recapture the disclosed devices in the '426 patent that do not meet the terms of the "bowl-shaped convex" limitation. The patentee is estopped from obtaining a reissue covering such devices, just as the patentee would have been estopped from arguing that a device which does not meet the terms of the "bowl-shaped convex" limitation infringes the claims of the '426 patent. There is simply no error to correct by reissue. It is wholly immaterial that the claims asserted by reissue attempt to describe the retaining member in language not appearing in the '426 patent claims, and can therefore be said to be "narrower" with respect to an element "germane to the prior art rejection" of the claims that were canceled and/or amended prior to allowance of the '426 patent. Application of the correct legal standard to the facts of this appeal shows that the rejection of claims 15-22 under 35 U.S.C. § 251 should be sustained.

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<sup>35</sup> See n. 32, *supra*.

<sup>36</sup> The Board is invited to consider that insofar as the embodiment of Figure 9 shows an element 61 as being applied to a cylindrical magnet, Figure 9 illustrates a discrete member (pre-applied coating as per the disclosure) which is a retaining member that is friction fitted into the bore outboard of the magnet, and which may be considered to have, at its "open" end, an external boundary (periphery) that is a closed circle so as to satisfy claim 9. The devices illustrated in Figures 8 and 9 clearly read on claim 15. However, the Board should note that appellant did not consider the '248 application to be drawn to other than the flat disk embodiment. See n. 19 and n.21, *supra*.

In the paragraph following footnote 9 of the Board's decision, the Board concluded that while the reissue claims deleted the limitation of the shape of the retaining member, which was relied upon to overcome the prior art rejection, the reissue claims recited a new and different limitation on the shape of the retaining member, which was narrower than the "surrendered subject matter." Assuming *arguendo*, that the Board was correct in considering that a claim can be both broadened and narrowed with respect to the same limitation and therefore properly attempted to extrapolate the analysis in Clement to apply to the facts of this appeal, the Board should reconsider its conclusion that the narrowing aspect somehow outweighs the broadening aspect. The narrowing of the claim cannot constitute the correction of an error without deceptive intent, as required by 35 U.S.C. § 251 when it is clear, on the facts, that the presentation of the "bowl-shaped convex" limitation was argued as being the reason for patentability (which the potentially infringing public is entitled to rely upon in its interpretation of the claim scope, especially in view of Hester, supra), that no continuation to prosecute broader claims was filed, and that when appellant in fact filed a divisional application, that application did not pursue the broadening aspect of the '426 claims now being asserted. Nor is it dispositive that the absence of a prior art rejection of the reissue claims in this case should illustrate that a particular limitation is "germane to a prior art rejection" in the context of the original patent application and the "surrendered subject matter" therein. Certainly, a prior art rejection could not be made in the original application with respect to a limitation that was not then of record. Failure to make a prior art rejection in the reissue application should not in any way preclude a holding of improper recapture under 35 U.S.C. § 251.

In footnote 10 of the Board's decision, the Board attempted to distinguish the facts of the present case from the facts of Pannu. Again assuming, *arguendo*, that the definition of "surrendered subject matter" is as stated by the Board in its decision, the facts in the Pannu



case clearly indicate that a reissue claim which is both as broad as the “surrendered subject matter” in an aspect germane to a prior art rejection and narrower than the “surrendered subject matter” in an aspect germane to a prior art rejection (as the Board defines the “aspect germane...”) is barred by the recapture doctrine and thus can not be reissued under 35 U.S.C. § 251. This follows from the fact that the Pannu case involves a fact situation in which a reissue claim was presented that was narrower than “the surrendered subject matter” (that is, narrower than the claim that was canceled to secure allowance of the original patent) in a manner clearly germane to a prior art rejection (as the Board defines it), but was also broader than “the surrendered subject matter” with respect to the very same element of the invention that was amended to avoid the prior art rejection. The emphasized material in the claims reproduced below illustrates the limitations that were narrowed, and argued, as being the patentable subject matter, all of which were directed to the flexible retention element(s) affixed to the lens body, referred to by the court as “haptics.”<sup>37</sup>

The originally presented claim 1 in the Pannu application read (Emphasis added in bold):  
A posterior chamber intraocular lens comprising:

A lens having a width and a thickness;

**a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;**

and a snag resistant disc joined to the flexible strand's free end;

said snag resistant disc having a width which is at least 3 times [\*1369] greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;

said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

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<sup>37</sup> It is not clear whether the plural “haptics” refers to there being two flexible retention members as per the amended claims that replaced the original claim which only recited “a retention loop.”

Claim 16 replaced claim 1, and read (Emphasis added in bold):

An intraocular lens comprising:

a lens body;

**at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;**

**said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.**

After what the court describes as “minor amendments,” claim 16 was allowed as patent claim 1 in this form (Emphasis added in bold):

An intraocular lens comprising:

a lens body;

**at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;**

**said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,**

said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

What was issued as claim 1 in the reissue patent (that was granted to patentee in the Pannu case) was a claim which omitted the language:

“defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and”

As can be easily seen by comparing the omitted language to the language reproduced in bold, reissue claim 1 is narrower than original application claim 1 with respect to the flexible retention element (presented merely as a “retention loop” in original application claim 1), which was argued as being the point of patentability during prosecution of the original patent application, but reissue claim 1 is broader than the allowed patent claim as to the omission of the “substantially circular arc having a diameter greater than the diameter of said lens body” limitation. Importantly, the court did not compare reissue claim 1 with the limitations involving the retention element to the originally presented application claim 1. Had the court done so, the court would have been compelled to find that reissue claim 1 defined the retention feature of the invention in a substantially narrower manner than it was defined in the original application claim 1 and therefore, that the reissue claim was not broader than the “surrendered subject matter” (as that term is defined by the Board in the present appeal) in an aspect “germane to a prior art rejection,” but was in fact narrower<sup>38</sup>. Thus, if one were to rely upon the Clement test as the Board has done in this case (using the Board's definition of terminology), one would be hard pressed to hold that the reissue claims were barred by 35 U.S.C § 251, because the reissue claims are simply not broader than the “surrendered subject matter” with respect to an element that was germane to the prior art rejection.

Yet that is precisely the holding of the court in Pannu. The court did not pay attention to the fact that reissue claim 1 describes the flexible retention elements in narrower terms than “the surrendered subject matter” as defined by the Board. Rather, the court focused on the fact that the shape of these elements had been limited as part of an amendment which resulted in

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<sup>38</sup> For example, the reissue claims require at least two flexible retention elements, and that they be integrally formed with the lens as a one-piece construction. The original application claim 1, canceled to secure allowance, only required a single such element, and that this element merely “be joined to” the lens.

the allowance of the original Pannu patent, without engaging in much analysis, and certainly without engaging in a Clement type analysis. Instead, the Pannu court stated that:

“if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture.”

For the Pannu court, it was enough that a limitation which was added to overcome a prior art rejection (in the prosecution leading to the patent) was omitted in the reissue patent. The reissued claim was barred by the recapture doctrine and thus can not satisfy 35 U.S.C. § 251.

The Board's dismissal of the relevance of the Pannu case on the basis that “the facts of the present case are distinct from the facts of” the Pannu case is, therefore, respectfully submitted to have been clearly erroneous. The Pannu court clearly premised its decision on the fact that a claim limitation added and argued with respect to patentability had been eliminated by reissue. The court found that this was not the correction of an error within the meaning of 35 U.S.C. § 251, because adding a limitation and then arguing that the limitation conveys patentability as an intentional act and not an error within the meaning of 35 U.S.C. § 251.

Although the patentee asserted in a reissue oath or declaration that the added and argued limitation was unnecessarily narrow, the patentee was held to be estopped from recapturing that limitation by canceling it in from the patent claim by way of reissue. Therefore, the Pannu case is clearly relevant to the facts of the present appeal, which clearly involves the attempt to remove from patent claims a limitation added and argued to overcome a prior art rejection. In fact, the facts in this appeal, in which the reissue claims are narrower than the original application claims notwithstanding that they are broader than the patent claims, appear to be mirrored in the Pannu case to the extent that the flexible retention elements claimed in the Pannu reissue patent are clearly claimed more narrowly (in the reissue patent) than they were claimed in the original application claims, although they are claimed more broadly than they

were claimed in the original patent. Analogous to what was done in Pannu, the original reissue declaration of record in this case states that claiming the restraining element as a “bowl-shaped, convex” member was unduly limiting. It is clear that just as the reissue claims did not pass muster under 35 U.S.C. § 251 in Pannu as being barred as recapture, claims 15-22 in this appeal should be barred by the recapture doctrine and thus should not be reissued under 35 U.S.C. § 251.<sup>39</sup>

To further emphasize the points made above:

In Clement, when discussing what is, or is not, surrendered, the Court presented (1) the possibility of reissue claim broadening in an “aspect germane to” the prior art rejection and narrowing in an aspect not germane to the prior art rejection, and (2) the possibility of claim broadening in an aspect unrelated to a prior art rejection and narrowing in an aspect germane to a prior art rejection. The Court did not present the third possibility of broadening in an aspect germane to the prior art rejection and narrowing in an aspect germane to a prior art rejection. The Board has apparently placed the present fact situation within this third possibility and decided that there has been no recapture of surrendered subject matter. In doing so, the Board has apparently decided that where the combination of AB is surrendered in favor of ABC<sub>sp</sub> in the application, the reissue can properly present ABC<sub>br</sub> in place of ABC<sub>sp</sub>. This presumes that C<sub>br</sub> is “germane” to the prior art rejection since ABC<sub>br</sub> defines over the prior art, just as ABC<sub>sp</sub> defined over the art in the application. This definition is, however, faulty because applicant/patentee surrendered the potential combination of ABC<sub>br</sub> by limiting the claims to ABC<sub>sp</sub>. The public has a right to believe it can practice any invention other than ABC<sub>sp</sub>, since applicant surrendered all

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<sup>39</sup> With respect to the Board’s comment regarding claim 18 which appear in footnote 9 of the Board’s decision, it would appear that claim 18 does not cure the stated error that the claims are too narrow by reason of the inclusion of the “bowl-shaped convex” limitation, and was therefore properly rejected under 35 U.S.C. § 251 because it is a claim containing that limitation. If the Board believes that affirming the Section 251 rejection on this basis would amount to a new grounds of rejection under 37 CFR 1.196(b), then the Board is invited to so designate it.

other inventions by amending the claim to require ABC<sub>sp</sub>, in response to the prior art applied in the application. Even assuming that the ABC<sub>br</sub> combination is “germane” to the prior art rejection as the Board apparently does, Pannu clearly addresses the situation of both the broadening limitation and the narrowing limitation being germane to the art rejection (as the Board appears to define it), and the Pannu court found there to be an impermissible recapture of surrendered claim subject matter. The result should be no different in the present case.

### Conclusion

For the foregoing reasons, it is submitted that the examiner has set forth a proper *prima facie* case establishing the unpatentability of claims 15-22 under 35 U.S.C. § 251. The *prima facie* case is based upon appellant’s attempt to improperly recapture subject matter which appellant surrendered by (a) canceling (in the original application) all claims directed to other than a “bowl-shaped convex” retaining member during the prosecution of the ‘426 patent, and (b) **twice arguing** that the “bowl-shaped convex” limitation which appellant is now attempting to remove from the claims by way of this reissue application constituted a reason for patentability of claims containing this limitation. The evidence of record confirms that appellant intentionally surrendered claims to all but one of the disclosed embodiments that did not include the “bowl-shaped convex” limitation, because while appellant filed a divisional application specifically limited to one of a plurality of embodiments not containing that limitation, appellant did not file a continuation application attempting to prosecute or appeal the rejection of the claims containing embodiments alternative to the “bowl-shaped convex” limitation which were canceled to secure allowance of the ‘426 patent.<sup>40</sup> The only alternative embodiment pursued was that of the divisional application. By reason of the surrender of claims not containing the “bowl-shaped convex” limitation, (except as secured in the divisional application), appellant is estopped from

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<sup>40</sup> See Maxwell v. Baker, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996)

attempting to recapture claims to such subject matter through the mechanism of reissue. In order to be able to determine what subject matter is the property of appellant and what subject matter disclosed by appellant has been placed in the public domain as a result of the intentional conduct of appellant (i.e., surrender of subject matter), the public is entitled to rely upon the prosecution history created by appellant during the prosecution of the original application, as well as the related evidence extrinsic to that prosecution history. Any "error" alleged in the '426 patent with respect to the unnecessary inclusion in all of that patent's claims of the "bowl-shaped convex" limitation is not a true "error" within the meaning of 35 U.S.C. § 251, but rather is the result of intentional actions on the part of appellant that established a surrender of subject matter. The intentional presence of the "bowl-shaped convex" limitation in the '426 patent claims is simply not an "error" under 35 U.S.C. § 251 (upon which a reissue may be based), as that term has been understood and defined in the law for more than 100 years.

Therefore, it is respectfully requested that the Board decision of August 3, 2001, in the above-identified application be reconsidered and that the rejection of claims 15-22 under 35 U.S.C. § 251 be sustained as to the reissue claims being an improper recapture of the subject


matter previously surrendered by appellant, i.e., subject matter which does not include a "bowl-shaped and generally convex..." retaining member.

Respectfully submitted,

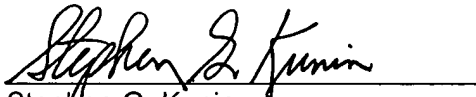


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